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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/825,352
Filing Date: April 15, 2004
Appellant(s): SCHOENBERG, ROY

Jody C. Bishop
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 10, 2009 appealing from the Office action mailed May 15, 2009.

(1)   Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

7,304,528	Kerr, II	12-2007
6,041,347	Harsham	3-2000
2004/0205540	Vulpe	10-2004

7447663	Barker	11-2008
2005/0216313	Claud	9-2005
6,398,727	Bui	6-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3.   Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In line 7 of claim 35, it is not clear what the word "respective" is intended to mean. It is not clear whether "respective" refers to different (as in greater or lesser) levels of security or whether "respective" simply refers to separate confidentiality levels (as in different access keys for different sets of medical records). Appropriate correction and/or clarification is required. For the purposes of examination, the Office will interpret the term "respective" to mean either varying levels of security or as meaning separate access keys.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

5.   Claims 1-8, 11-14, 17, 28-31 and 34 are rejected under 35 U.S.C. 103(a) as being

unpatentable over US Patent Number 7,304,852 to Kerr, II et al. in view of US Patent Number

6,041,347 to Harsham in further view of US Patent Application Number 2004/0205540 to

Vulpe.

(A)   As per claim 1, Kerr teaches a rule processing computer-based method (Kerr:

Abstract) comprising:

defining a target group of patients chosen from a group of existing patients (Kerr; Col. 9,

Ln. 1-30);

defining an action to be taken concerning one or more patients within the

target group of patients (Kerr: Col. 1, Ln. 1-30); and

scheduling an execution time for the action (Kerr: Col. 9, Ln. 1-30);

initiating by the computer, in accordance with the scheduled execution time, the action

concerning corresponding patients to which the determined one or more medical records

that satisfy the rule relate (Kerr: Col. 9, Ln. 1-30).

Kerr does not teach the following features which are taught by Harsham:

receiving user input to a processor-based computer for defining a computer-executable

rule (Harsham: Col. 5, Ln. 61-Col. 6, Ln. 29). At the time of the invention, it would have

been obvious for one of ordinary skill in the art to have modified Kerr with the

aforementioned teachings from Harsham with the motivation of having a means of configuring a

computer network in an object-oriented manner, as recited in Harsham (Col. 5, Ln. –Col. 6, Ln.

19).

The combined teachings of Kerr in view of Harsham do not teach the following feature

which is taught by Vulpe (Sections [0069] and [0080]):

processing, by the computer, a plurality of computer-based records against said

computer-executable rule to determine one or more of said medical records that satisfy the rule,

wherein each of the medical records contain at least a portion of a corresponding patient's

medical history stored to computer-readable medium (Note: Vulpe recites that its system is used

for records but does not state that the records are medical records, however, the Office takes the

position that the term "records" in Vulpe includes medical records).

At the time of the invention, it would have been obvious for one of ordinary skill

in the art to have modified the combined teachings of Kerr in view of Harsham with the

aforementioned teachings from Vulpe with the motivation of having a means of determining

which records satisfy a particular rule, as recited in Vulpe (Vulpe: Section [0069]).

(B)   As per claim 2, in Kerr the processing includes

processing the medical records of the existing patients to determine which of the medical

records define the existence of a selected condition (Kerr; Col. 9, Ln. 1-30).

(C)   As per claim 3, Kerr teaches that the selected condition concerns a medical

condition of a patient (Kerr; Col. 9, Ln. 1-30).

(D)   As per claim 4, Kerr teaches that the selected condition concerns a physical

criteria of a patient (Kerr: Col. 9, Ln. 1-30).

(E)   As per claims 5-6, Kerr teaches that the selected condition teaches a habit of a

patient or activity of a patient (Kerr: col. 1, Ln. 12-31).

(F)   As per claim 7, in Kerr the action includes one or more of:

posting a HTML link for a patient;

posting a message for a patient;

providing a tool to a patient;

transmitting an email to a patient;

updating a patient's medical record;

transmitting a pop-up message to a patient;

recommending that a patient join a discussion board;

providing a patient with medical information;

providing a medical report to a patient;

providing a medical report to a third party;

executing a program; and

notifying a third party (Kerr: Col. 2, Ln. 58-Col. 3, Ln. 3 and Col. 9, Ln. 1-30).

(G)   As per claim 8, Kerr teaches that the step of scheduling an execution time

includes specifying a single, non-recurring, execution time (Kerr: Col. 2, Ln. 58-Col. 3,

Ln. 3).

(H)   As per claim 11, Kerr the step of initiating the action in accordance with the scheduled execution time comprising initiating on or after the execution time the action concerning the corresponding patients to which the determined one or more medical records that satisfy that rule relate (Kerr: Col. 2, Ln. 58-Col. 3, Ln. 3 and Col. 9, Ln. 1-30).

(L)   As per claims 29-31 and 34, these claims are substantially similar to Claims 1-8 and 11, above, and are therefore rejected on the same basis, which is set forth above.

6.   Claims 9-10, 15-16 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerr, as applied to Claim 1, and in further view of US Patent Number 7,447,663 to Barker.

(A)   As per claims 9-10, Kerr does not teach that the step of scheduling an execution time includes specifying a plurality of non-recurring execution times nor does Kerr teach that the step of scheduling an execution time includes specifying a recurring execution time, however, this feature is taught in Barker (Col. 5, Ln. 17-36). At the time of the invention it would have been obvious for one of ordinary skill in the art to have modified the teachings of Kerr with these aforementioned teachings from Barker with the motivation of having means of allowing a user or a client to specify the criteria or conditions (e.g. frequency of occurrences) that a certain rule would be executed, as recited in Barker (Col. 5, Ln. 17-36).

(B)   As per claims 15-16 and 32-33, these claims are substantially similar to Claims 9 and 10 and are therefore rejected on the same basis, as is set forth above.

7.   Claims 12-28 and 35-40 are rejected under 35 U.S.C.103 (a) as being unpatentable over Kerr in view of US Patent Application Publication 2005/0216313 to Claud and in even further view of US Patent Application Number 2004/0205540 to Vulpe and in even further view of US Patent Number 6,398,727 to Bui.

(A)   As per claim 12, the combined teachings of Kerr in view of Claud in view of Vulpe in view of Bui teach a rule processing computer-based method comprising:

determining by a computer, for a specific computer-executable rule that is stored to a computer-readable medium, a target group of patients (Kerr: Col. 9, Ln. 1-30);

determining for a specific rule, an action to be taken concerning one or more patients within the target group of patients (Kerr: Col. 9, Ln. 1-30);

determining for said specific computer-executable rule, an execution time for the action (Kerr: Col. 9, Ln. 1-30); and

initiating by the computer the action concerning the one or more patients within the target group of patients on or after the execution time (Kerr: Col. 9, Ln. 1-30).

Kerr does not each the following feature which is taught by Claud (Section [0096]):

wherein said target group of patients comprise at least a subset of patients for whom a particular medical service provider has an access key that grants the medical service provider access to medical records of the patients

At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Kerr with these aforementioned teachings from Claud with the motivation of having a means of permitting only authorized users to access patient information, as recited in Claud (Section [0100]).

The combined teachings of Kerr in view of Claud do not teach or suggest a computer-executable rule which is initiated by a computer whose respective medical records satisfy the specific computer-executable rule, however, this feature is taught by Vulpe (Sections [0069] and [0080]). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Kerr in view of Claud with the aforementioned teachings from Vulpe with the motivation of having a means of determining which records satisfy a particular rule, as recited in Vulpe (Vulpe: Section [0069]).

The combined teachings of Kerr in view of Claud in view of Vulpe do not teach or suggest the step of communicating information to one or more patients, however this feature is well known in the art as is illustrated by Bui (Col. 17, Ln. 29-40). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Kerr with these aforementioned teachings from Bui with the motivation of having a means of communicating information to a patient as recited in Bui (Col. 17, Ln. 29-40).

(B)   As per claims 13-17, these claims are substantially similar to claims 7-11 and are therefore rejected on the same basis as these claims which is set forth above.

(C)   As per claims 18-19, these claims are substantially similar to claims 12 and 1, above, respectively and are therefore rejected on the same basis as these claim, which is set forth above.

(D)   As per claims 20-23, these claims are substantially similar to claims 3-6 and are therefore rejected on the same basis as these claims, which is set forth above.

(E)   As per claims 24-28, these claims are substantially similar to claims 7-11 and are therefore rejected on the same basis as these claims, which is set forth above.

(F) As per claims 35-40, these claims are substantially similar to claims 1-11 and 12-27 and are therefore rejected on the same basis as these claims, which is set forth above.

(10) Response to Argument

Applicant's arguments will be addressed in sequential order as they were presented in the Appeal Brief October 9, 2009.

(1) With regard to the applicant's argument that the term "respective" is not indefinite, the Office takes the position that it is not clear whether "respective" refers to different (as in greater or lesser) levels of security or whether "respective" simply refers to separate confidentiality levels (as in different access keys for different sets of medical records).

(2) With regard to the 35 U.S.C. 103(a) rejections over the claims, the applicant argues that the applied combination of references fails to teach or suggest receiving user input for defining a rule for identifying a target group of patients chosen from a group of existing patients.

To respond to this argument, the Office would like to point out that the Kerr patent reference clearly teaches this feature (Kerr: Col. 9, Ln. 1-30).

(3) With regard to the 35 U.S.C 103(a) rejections over the claims, the applicant argues that the applied combination of references fails to teach or suggest processing medical records against the rule to determine one or more of said medical records that satisfy the rule.

To respond to this argument, the Office would like to point out that the Kerr patent reference clearly teaches this feature (Kerr: Col. 9, Ln. 1-30).

(4) Applicant argues that there is no apparent reason to combine the references. To respond to this argument, the Office would like to point out that appropriate motivation has been

set forth above in the 35 U.S.C. 103(a) rejections to combine all the secondary references with the primary reference.

(5)   Applicant argues that the Claud patent reference is not proper prior art that can be used in rejecting claims 12-28 and 35-40. To respond to this argument, the Office would like to point out that Schoenberg declaration does not seem to provide adequate support that an embodiment of the invention was reduced to practice for its intended purpose prior to the earliest priority date of Claud. Specifically, it is not clear what portions of the Schoenberg declaration are being relied on to show that the applicant had possession of the invention and that the invention was reduced to practice prior to the earliest priority date of Claud.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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